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WHITE BLACK LEGAL is an open access, peer-reviewed and refereed journal provide dedicated to express views on topical legal issues, thereby generating a cross current of ideas on emerging matters. This platform shall also ignite the initiative and desire of young law students to contribute in the field of law. The erudite response of legal luminaries shall be solicited to enable readers to explore challenges that lie before law makers, lawyers and the society at large, in the event of the ever changing social, economic and technological scenario.

With this thought, we hereby present to you

WELL KNOWN TRADE MARKS IN INDIA: CHALLENGES IN ENFORCEMENT ACROSS JURISDICTION

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Abstract

Well-known trademarks constitute a crucial category of intellectual property protection as their value lies not only in distinctiveness but also in the reputation and consumer trust. The Indian Trademarks Act 1999 recognises and protects well-known trademarks even without registration and also protect them against dilution, unfair advantage and misuse across dissimilar goods. Despite of this progressive framework enforcement in India it remains fragmented due to jurisdictional inconsistencies and divergent judicial approaches. Court varies significantly in assessing trans-border reputation, evidentiary standards and threshold for consumer recognition resulting in conflicting precedents that undermine legal certainty. Digital infringement and online commerce introduce further complexity by blurring territorial boundaries and challenging traditional notions of jurisdiction. This paper examines these structural and interpretative challenges and argues for harmonized evidentiary standards and institutional coordination to ensure consistent, predictable and effective enforcement of well-known trademarks across Indian jurisdictions.

Key words

Well-known trademark, cross-jurisdiction enforcement, Trans-border reputation, Jurisdictional challenges, Trademark dilution, Trade Marks Act, 1999, Brand protection, Digital infringement

1. INTRODUCTION

Intellectual property has been traditionally categorized into industrial property and copyright. The term industrial property includes patents, trademarks, industrial designs and geographical indications of sources and copyrights. Intellectual property rights are generally said to be a bundle of exclusive rights granted to the lawful owner. According to Nordberg¹ it is important

¹ Karin Nordborg ,available at https://gupea.ub.gu.se/bitstream/2077/22651/1/gupea_2077_22651_1.pdf

to understand the difference between trademark and brand but also the symbiotic relationship that exists between them. “Trademark” is the legal term and represents a distinctive mark or symbol to which an owner can obtain an exclusive right whereas “well known mark” is a broader term also including associations produced by a trademark, such as goodwill, image and prestige. Well known trademarks represent a special class of IP because they encapsulate the goodwill and reputation accumulated through extensive commercial use, consumer trust and brand recognition. Their value often transcends geographical boundaries and market segments, making them powerful commercial assets in a globalised economy. In India the significance of well-known trademarks has grown substantially due to expansion of international trade, increased consumer exposure to global brands and widespread digital advertising. Although the Trademarks Act 1999 provides a comprehensive statutory framework to protect such marks, their enforcement across different Indian jurisdictions remains inconsistent and fragmented. Courts diverge in their interpretation of trans border reputation, jurisdictional principles, evidentiary requirements and the scope of dilution resulting in the lack of uniformity in the legal protection offered to well-known trademarks. The emergence of the internet and digital marketplaces has further complicated enforcement, thereby blurring the traditional territorial boundaries. This paper examines these complexities in detail and highlights the areas that require harmonisation and reform to strengthen the enforcement of well-known trademark rights in India.

2. UNDERSTANDING WELL-KNOWN TRADEMARKS

2.1 Definition under the Trademarks Act 1999

The trademarks Act 1999 defines well-known trademarks under section 2 (1)(zg) “*well-known trade mark*”, *in relation to any goods or services, means a mark which has become so to the substantial segment of the public which uses such goods or receives such services that the use of such mark in relation to other goods or services would be likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and a person using the mark in relation to the first-mentioned goods or services*².”

The definition emphasises the broad recognition that the mark must enjoy within the Indian public, irrespective of its geographical or product specific association. It aligns Indian law with global standards particularly with TRIPS agreement, which mandates an expanded level of

(last visited November 20, 2025).

² Trade Marks Act 1999, s 2(1) (zg).

protection for well-known trademarks. This recognition underscores the India legal systems acknowledgement of the economic and reputational value that globally recognised marks carry, warranting protection even in the absence of formal registration.

2.2 Criteria For Determination

Section 11(6) to (9)³ of the Trade Marks Act 1999 sets out the principles for determining whether a trademark is well-known in India. The registrar may consider any relevant factor, including the level of recognition among the relevant public, the duration and geographical extent of the marks use and promotion, its registration history and successful enforcement actions or prior recognition by courts or the registrar. To assess public recognition, the registrar must take into account the number of actual or potential consumers, persons involved in distribution channels and business circles dealing with the concerned goods or services. Once a mark has been recognised as well-known by any court or by any registrar for any relevant segment of the public, it must be treated as a well-known trademark for registration purpose. Importantly, the law specifies that well-known status does not require proof of use, registration, or pending application in India, nor registration or recognition abroad, nor that the mark is known to the public at large. These statutory provisions ensure that recognition is not dependent merely on fame but on demonstrable evidence of widespread consumer association. The flexible nature of the criteria enables the authorities to evaluate a large variety of marks both domestic and international and determine their well-known status based on contextual relevance rather than strict quantitative measures.

2.3 Importance of well-known status

A well-known trademark enjoys broader protection than an ordinary trademark. The Trademark Act 1999 grants such marks protection even in relation to dissimilar goods or service if the use of the mark by an unauthorized party is likely to indicate a connection or cause dilution⁴. This protection ensures that the distinctiveness and reputation of the marks are not weakened by misuse in unrelated markets. Furthermore, well-known marks enjoy protection against passing off even without registration, which reinforces their elevated position within trademark jurisprudence. The objective behind this enhanced protection is to safeguard the investment made by trademark proprietors while also preventing unfair

³ Trade Marks Act 1999, s 11(6)–(9).

⁴ *Kirloskar Diesel Recon Pvt Ltd v Kirloskar Proprietary Ltd* [1996] (Bom HC).

advantage, consumer confusion and brand dilution.

3. STATUTORY FRAMEWORK

3.1 Protection Against Dilution

Section 29(4) of the Trade Marks Act 1999 represents a major shift from traditional trademark protection by offering remedies against dilution even when the infringing party uses the mark in relation to dissimilar goods or services⁵. This provision addresses situations where a third-party attempts to free ride on the reputation of a well-known mark or undermine its distinctiveness by using it for unrelated products. Dilution protection is thus concerned not with consumer confusion but with preserving the economic and symbolic value of well-known marks. Indian courts have applied this provision in several landmark cases, emphasising the need to maintain the sanctity of well-known trademarks and prevent misuse that exploits their established reputation.

3.2 Protection Without Registration

Indian trademarks law recognises that well-known trademarks deserve protection irrespective of formal registration. This principle rooted in common law and reinforced by statutory provisions, reflects the understanding that reputation and goodwill are earned through use rather than registration⁶. Courts have repeatedly emphasised that the absence of registration cannot be used as a defence against infringement or passing off when the mark has acquired widespread recognition. This approach ensures that genuine brand owners receive effective protection against unfair commercial practices, especially in cases involving global brands that may not have had early registrations in India.

3.3 Administrative Recognition: 2017 Amendment

The Trade Marks Rules 2017 introduced a significant change by empowering the registrar of trademarks to recognise well-known trademarks through an administrative process based on submitted evidence⁷. This mechanism allows proprietors to obtain nationwide recognition without engaging in prolonged litigation. However, the process has been criticised for lacking transparency, particularly with respect to the evaluation of evidence and the absence of a robust opposition procedure. The potential for inconsistency between administrative recognition and

⁵ Trade Marks Act 1999, s 29(4).

⁶ *Mac Personal Care Pvt Ltd v Laverana GmbH & Co KG* [2016] (Del HC).

⁷ Trade Marks Rules 2017, r 124.

judicial determinations remains a concern, raising questions about the coherence and credibility of the overall enforcement framework. Nevertheless, the amendment marks an important step towards modernising trademark administration in India.

4. JUDICIAL INTERPRETATION

The Supreme court's decision in *NR Dongre v. whirlpool corporation*⁸ was a turning point in Indian trademark jurisprudence. The court held that well-known marks enjoy protection in India even when the goods are not marketed in the country, provided the mark has acquired trans-border reputation through advertising or brand presence. This case firmly established that reputation is not confined to physical sales but can result from global advertising efforts. The decision strengthened the doctrine of spill-over reputation and ensured protection for internationally brands in India even before they formally entered the India market.

In *Daimler Benz AG v. Hybo Hindustan*⁹, the Delhi high court delivered a landmark judgment in favour of the German automobile manufacturer. The court prohibited the defendant from using the "Benz" mark on undergarments, emphasising that such use would dilute the reputation of the globally renowned automobile brand. This judgement illustrated India's willingness to protect well-known marks across unrelated classes of goods and highlighted the principle that certain trademarks deserve the highest degree of protection due to their exceptional reputation a distinctive character.

The Supreme court's ruling in *Toyota Jidosha Kabushiki Kaisha v Prius Auto Industries*¹⁰ marked a significant shift in the approach to trans-border reputation. The decision of the Court indicates that for Indian Recognition to be proven, adequate evidence should be provided showing the level of consumer awareness in India during the relevant date. The Court rejected the concept that an International Company's Global Reputation will automatically translate to Indian Recognition. This Judgment outlines the evidentiary standards for proving a "spill over reputation" and imposes a greater burden on the owner of an International Trademark seeking to establish both Global Fame and Domestic Recognition in India.

In *Rolex SA v. Alex Jewellery Pvt.Ltd.*¹¹ the Delhi High Court reiterated the importance of

⁸ NR Dongre v Whirlpool Corporation (1996) 5 SCC 714.

⁹ Daimler Benz AG v Hybo Hindustan 1994 PTC 287 (Del).

¹⁰ Toyota Jidosha Kabushiki Kaisha v Prius Auto Industries Ltd (2017) 2 SCC 35.

¹¹ Rolex SA v Alex Jewellery Pvt Ltd 2009 (41) PTC 284 (Del).

Strang enforcement history in determining well-known status. The court ruled that the “Rolex” trademark enjoyed exceptional recognition due to its longstanding market presence and consistent enforcement efforts. This judgement underscored the significance of proactive brand management, as courts are more willing to recognise marks that demonstrate ongoing vigilance against infringement.

The issue of internet – based infringement was addressed in *Banyan Tree Holding v. A Murali Krishna Reddy*¹² where Delhi High Court established the “Purposeful Availment” test for determining jurisdiction in online disputes. The court held that mere accessibility of a website in a particular jurisdiction does not confer territorial jurisdiction unless the defendant purposefully directed activities towards that jurisdiction. This principle attempts to balance the expansive nature of online accessibility with the need to prevent forum shopping.

5. CHALLENGES IN ENFORCEMENT ACROSS JURISDICTIONS

5.1 Divergent Jurisdictional Interpretation

Courts across India have taken an inconsistent approach to territorial jurisdiction concerning well-known trademarks and this inconsistency has created significant challenges for trademark owners trying to establish their rights over well-known trademarks in India. Section 134 of the Trade Marks Act permits a plaintiff to file their suit in the jurisdiction of residence or business location. However, there have been differing views between the courts regarding what constitutes "business" activity; some courts take a broad view allowing a plaintiff to file where they have any kind of business presence (even if only nominal), while others require that the plaintiff must have more than just incidental business activity within the jurisdiction. Based on these differences, Courts' interpretations vary widely, resulting in significant delays when courts make decisions, and leaving many rights holders vulnerable to jurisdictional objections that create uncertainty regarding litigation outcomes and impose added pressure on rights holders to successfully enforce their well-known trademark rights.

The Indian judiciary exhibits divergent view regarding the evidence required to establish well-known status and trans-border reputation. The liberal approach exemplified by *Whirlpool* has been tempered by the stricter evidentiary demands imposed in *Toyota Prius*. As a result, trademark proprietors face uncertainty about the level of proof required, particularly regarding consumer surveys, advertising records and market studies. Different High Courts

¹² *Banyan Tree Holding (P) Limited v A Murali Krishna Reddy* 2010 (42) PTC 361 (Del).

may apply different standards, making it difficult for rights holders to rely on consistent legal principles. This lack of uniformity affects not only litigation outcomes but also strategic decisions regarding brand protection.

The dual mechanism for recognising well-known trademarks has generated confusion and conflict. While the registrar can grant recognition based on the evidence submitted courts may arrive at different conclusions when adjudicating disputes involving the same mark. The lack of an effective opposition mechanism in the administrative process raises concerns about the potential for arbitrary recognition. Furthermore, the absence of an appellate structure for challenging administrative recognition creates a gap in the system. These issues undermine the reliability of the registrar's list and weaken the coherence of the trademark enforcement regime.

5.2 Digital Infringement and Expanding Boundaries

Due to the ongoing growth of digital platform use, trademark enforcement has become increasingly difficult, as infringing goods are often available on e-commerce websites, and counterfeit merchandise is marketed through social media channels. In addition, domain names are consistently registered in bad faith. These activities create a complex web of violations that bubble up from the individual to the global level. The continued growth of global e-commerce has left traditional notions of territoriality behind. Courts across the globe have been inconsistent in their application of establishing jurisdiction by the mere accessibility of infringing websites. The recent ruling in the *Bayan tree* case attempted to provide clarification of this issue, yet the landscape of digital commerce continues to evolve at a rapid rate, further complicating enforcement efforts.

The enforcement of trademarks in India occurs through numerous forums, including the High Court, Commercial Courts, Customs, and the Registrar of Trademarks. This fragmentation leads to overlaps in proceedings, confusion regarding decisions, and extended timelines to resolve disputes. Furthermore, without a coordinated sharing mechanism between the institutions involved, it becomes increasingly difficult for rights holders to enforce their rights against infringers who are utilizing gaps between institutions. Additionally, due to inconsistencies in how different jurisdictions interpret similar circumstances, duplicative offending becomes less manageable through enforcement mechanisms.

5.3 Inconsistent Remedies

Courts in India vary widely in awarding remedies such as punitive damages, interim injunctions and ex parte relief. While some courts impose substantial penalties to deter infringement, others

limit relief to simple injunctions. This inconsistency reduces the deterrent effect that is essential to protect well-known trademarks. The unpredictability in obtaining relief also discourages brand owners from engaging in enforcement actions, ultimately weakening the overall protection of well-known marks.

6. COMPARATIVE INTERNATIONAL APPROACH

6.1 European Union

The EU has a unified legal framework for providing protection for trade marks in Member States across the EU through the EU trade mark regulation and trade mark directive. Trade mark rights for marks with a reputation or well-known trade marks are protected in all Member States. The laws governing dilution and unfair advantage under the EU Trade mark Regulation are the same across all Member States. The EU has a unitary trade mark system which promotes consistency in enforcement, discourages fragmented litigation and allows the trade mark owner to avoid forum-shopping. The harmonised enforcement approach by the EU provides a more predictable method of obtaining enforcement of trade mark rights than the fragmented trade mark enforcement system in India.

6.2 United States

In the United States, the Federal Trademark Dilution Act and its Amendments offer extensive protection for Famous Marks across the U.S. The Act provides protection for these marks without the need for a showing of confusion or competition between the parties or proof of damage caused by dilution. The uniformity of the Act creates uniform enforcement within the United States, allowing for decreased ambiguity with regard to Jurisdictional Interpretation and Evidence Requirements, unlike in India.

6.3 China

China has taken significant steps to centralise the recognition and protection of well-known trademarks through the China national intellectual property administration¹³. The country follows a structured and transparent procedure for determining well-known status and its centralised administrative model ensures greater uniformity. Although practical challenges remain, China's approach provides valuable insights for India, particularly in terms of

¹³ China Trademark Law (2019 Amendment).

administrative efficiency and nationwide enforcement consistency.

7. RECOMMENDATIONS FOR STRENGTHENING ENFORCEMENT

7.1 Harmonising standards of evidence

India must establish unified and transparent evidentiary standards for determining well-known status. Detailed guidelines on the types of acceptable evidence, such as consumer surveys advertising expenditures, and digital reach metrics, should be issued to ensure consistency across jurisdiction, such guidelines will provide clarity for rights holders and reduce the uncertainty associated with varying judicial interpretations, thereby streamlining the recognition process.

7.2 Specialised intellectual property benches

The creation of specialised IP benches in high courts across India would greatly enhance the consistency and efficiency of trademark enforcement. Specialised judges with expertise in trademark law can better appreciate the nuances involved in well-known trademark disputes. The establishment of such benches would reduce procedural delays, produce more uniform decisions, and strengthen the overall enforcement framework.

7.3 Centralised national IP enforcement database

A centralised IP enforcement database accessible to courts, customs, police, and trademark offices would allow for better coordination and faster identification of repeat offenders. Such a database would help streamline enforcement actions, reduce duplication of efforts, and strengthen border measures against counterfeit goods. This approach would ensure that enforcement agencies operate with up-to-date information and follow a coordinated response.

7.4 Strengthened digital enforcement mechanism

Legislative reforms are required to clearly define jurisdiction in cases involving online infringement. Fast-track procedures for removing infringing content, coupled with stringent obligations on online intermediaries would significantly enhance digital enforcement. The law must adapt to the realities of e-commerce, influencer marketing, and social media advertising to ensure that well-known trademarks receive effective protection in the digital age.

8. CONCLUSION

A well-known trade mark is considered a powerful representative of quality, trust, and Commercial value which requires its continued protection through a globalised and digitalised environment; In addition to the solid framework provided by the Trade Marks Act 1999 for statutory protection, the enforcement of the rights associated with a well-known mark in India is inconsistent due to conflicting jurisdictions, differing standards of evidence, and a fragmented enforcement system. The complexities of the dual framework of both the court system and the administrative system create obstacles, and the increasing incidence of digital infringement creates more challenges. As a way to alleviate these challenges, India should work toward unifying its legal standards, developing stronger court expertise, ensuring transparency in administrative actions, and creating more effective enforcement systems. Providing uniform and effective protection for well-known trade marks will protect the rights of the owners and improve the confidence of consumers in the rights that they establish, thus making India a more prominent IP jurisdiction.

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